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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,035	09/29/2003	William H. Winters	NOVU004A	4497
21322	7590	04/27/2004	EXAMINER	
MARK A OATHOUT 3701 KIRBY DRIVE, SUITE 960 HOUSTON, TX 77098			LEE, JONG SUK	
			ART UNIT	PAPER NUMBER
			3673	
DATE MAILED: 04/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,035

Applicant(s)

WINTERS ET AL.

Examiner

Jong-Suk (James) Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 14, 15, 17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15, 16 and 19-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. The preliminary amendment filed September 29, 2003 has been entered.

Claim Objections

2. Claims 1, 12 and 23 are objected to because of the following informalities:

Claim 1, line 4: "about 20 mesh" is suggested to be --about 0.2 inch--.

Claim 12, line 3: "about 20 mesh" is suggested to be --about 0.2 inch--.

Claim 23, line 2: "about 20 mesh" is suggested to be --about 0.2 inch--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1 and 10: The phrase "such as" in lines 1 and 2, respectively, in each claim, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Re claims 8 and 9: The limitation, "said fence" in line 1, respectively, lacks clear antecedent basis. These claims appear to be dependent upon claim 7 and have been treated as such. Affirmation of this is required by appropriate amendment.

Claims 2-7 and 11-19 are also considered to be indefinite because they are dependent upon claims 1 and 10 respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 6, 10, 12, 15, 19, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Grabhorn (US 5,595,458).

Grabhorn'458 discloses a biofilter bags for erosion control of a granular earthly material, soil, comprising of: a pile/base product including a plurality of natural wood pieces/fragments, which are tree stumps, having a target size within the range of larger than 1.5 inches or smaller than 3/8 inches, the pile having a windrow shape as depicted in Figs. 2 and 5 (see col.1, lines 3-42 and 61-67; col.2, lines 1-62). Further, Graphorn'458 discloses a method for erosion control of soil comprising the steps of: accumulating a starter material from at least one natural wood material/tree stumps; processing, with a wood chipper, the starter material into a plurality of

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pieces/fragments within the targeted size; installing the base product along and on top of the ground with the bags filled with the base product by arranging them as a windrow (see col.2, lines 3-39).

With respect to the method steps of collecting wind blown particulate on the base product as to claim 15, it is believed to be inherent to have the particulate blown by wind under the strong wind blowing area, such as beach or open field.

7. Claims 1, 2, 6, 10, 12, 19, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by White (US 3,604,757).

The preamble limitation, “for reducing and reversing erosion of a granular earthy materialfrom an underlying ground such as a beach” in lines 1-2 is intended use and no patentable weight is given to the preamble.

White discloses a stacking and reclaiming system for storing wood chips comprising of: a pile/base product including a plurality of natural wood pieces/fragments/chips, which are inherent tree stumps, having a target size within the range of inherently larger than 1.5 inches or smaller than 3/8 inches as conventional size of the wood chips, the pile having a windrow shape. Further, White discloses an inherent method comprising the steps of: accumulating a starter material from at least one natural wood material/tree stumps; processing, with a conventional wood chipper, the starter material into a plurality of pieces/fragments within the targeted size; installing the base product along and on top of the ground with the bags filled with the base product by arranging them as a windrow (see Figs. 1-6; col.2, lines 23-75; col.3, lines 1-59).

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8. Claims 1, 2, 6, 10, 12, 19, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford (US 5,265,561).

The preamble limitation, “for reducing and reversing erosion of a granular earthy materialfrom an underlying ground such as a beach” in lines 1-2 is intended use and no patentable weight is given to the preamble.

Crawford discloses a process for bedding material comprising of: a pile/base product including a plurality of natural wood pieces/fragments/chips and cardboard box pieces, which are inherent tree stumps, having a target size within the range of larger than 1.5 inches or smaller than 3/8 inches (see col.2, lines 35-42; col.4, lines 9-32), the pile having a windrow shape. Further, White discloses an inherent method comprising the steps of: accumulating a starter material from at least one natural wood material/tree stumps; processing, with a conventional wood chipper (20), the starter material into a plurality of pieces/fragments within the targeted size; installing the base product along and on top of the ground with the bags filled with the base product by arranging them as a windrow (see Fig. 1; col.2, lines 29-68; col.3, lines 1-68; col.4, lines 1-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103[®] and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grabhorn'458.

The teachings of Grabhorn'458 have been discussed above.

Although Graphorn'458 fails to disclose or fairly suggest the method steps of installing an additional layer of the base product after the wind-blown particles collecting step and removing a portion of the base product after the collecting step, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have such steps of adding or removing the base product/biofilter bags filled with the wood fragments in order to adjust the arrangement of the bags for the best effect to the desired sites.

11. Claims 3-5, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabhorn'458 in view of Japanese Patent Application (JP 60-98017). The teachings of Grabhorn'458 have been discussed above.

However, Graphorn'458 fails to disclose or fairly suggest the pile/base product having a compost material and the method step of composting the base product. Japanese Patent Application discloses an artificial vegetation partitions on the slope for protecting the soil erosion comprising of: a soil in the partitions mixed with organic substances, such as bark compost, peat moss (see Figs.1-6; English-translated abstract and constitutions).

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Therefore, in view of Japanese Patent Application, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to add the compost material to the base product/pile of Grabhorn'458 in order to enhance the vegetation for the base product when the optimal environment for the seeding is met.

12. Claims 7, 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabhorn'458 in view of Harris (US 267,523). The teachings of Grabhorn'458 have been discussed above.

However, Graphorn'458 fails to disclose or fairly suggest a fence installed proximate a predominantly wind blown side of the pile/base product as the windrow. Harris discloses a flood fence (A) to protect the erosion of land including a pile of wood fragments/brushes (C) placed behind the fence as depicted in Figs. 1-2 (see page 1, lines 10-97).

Therefore, in view of Harris, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to add the fence in front of the pile/base product of Grabhorn'458 in order to double-kill the strongly blown-wind and rushed-wave to the seashore.

With respect to the location of the fence within the two feet from the pile as to claim 8, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to place the fence within such a range in order to provide the best effect of the erosion protection.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grabhorn'458 as modified by Harris, as applied to claim 7, and further in view of Parker (US 5,795,099). The

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teachings of Grabhorn'458 modified by Harris have been discussed above.

However, the teachings of Grabhorn'458 modified by Harris fails to specifically disclose the fence having a geo-textile material. Parker discloses an apparatus for controlling beach erosion comprising of a fence with geotextile mesh material (20) attaching to the fence frame (13) (see Figs. 1-4; col.3, lines 30-68; co.4, lines 1-58).

Therefore, in view of Parker, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to further modify the fence of Graphorn'458, as modified by Harris, by including the geotextile material to the fence frame in order to enhance the screening effect for the wave or wind including the sand or sediments.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other cited references disclose shoreline erosion protection systems, a method of manufacturing mulches and erosion control blanket on the slopes.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
April 22, 2004



Jong-Suk (James) Lee
Primary Examiner
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